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08/818,771    03/14/97    MIRASHRAFI    M    002784.P001

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| EXAMINER |
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NGUYEN, S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2731

DATE MAILED:

12/20/99

*6*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/818,771

Applicant(s)

Mirashrafi et al.

Examiner

Steven Nguyen

Group Art Unit

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☒ Responsive to communication(s) filed on 10/12/99 (amendment A)

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-3, 5-11, 13-25, 29, and 30 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3, 5-11, 13-25, 29, and 30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment A filed on 10/14/99. Claims 5, 12, 26-28 and 31-32 have been canceled and claims 1-4, 6-11, 13-25 and 29-30 are pending in the application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-3, 19-21, 24 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman (USP 5948061).

Regarding claims 1-3, Merriman discloses (Fig 1, Col 1, lines 7 to col 9, lines 15) a server for receiving a request from the client system to a target server, providing addition information from server and information from the target server to the client system, wherein (a user browser "16" accesses an ISP "16" to search for something, the advertising server "19" provides the user browser the content of target server "18" and addition content such as advertising from the server "19" to a user browser).

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Regarding claims 19-21 and 24, Merriman discloses (Fig 1, Col 1, lines 7 to col 9, lines 15) a server (Fig 1, Ref 19) for providing a control logic for receiving a request for content from the client system (Fig 1, Ref 16) targeting a network server (Fig 1, 18) checking whether an addition content inquiry is to be provided to the client system along with the content which provides by the network server, content adding logic which coupled to the control logic for providing the additional content to the client system if it is to be additionally provides (Merriman discloses a user login the affiliate web site "Fig 1, 12" searching for a target server "Fig 1, 18", the advertising server receives a request for content of target server, check to see if any addition content need to provide to the client system along with the content of the target server. The adverting server embedded the advertising into the content of target server HTML page then forwarding it to the client system).

Regarding claims 29, Merriman discloses (Fig 1, Col 1, lines 7 to col 9, lines 15) a client system which comprises a control logic to transmitting a request that target a network server and retransmit the request in the mark up form upon receiving a return of request from a bridge server (See Fig 1, the client system 16 transmitting a request that target a server; after receiving a marked up form from the bridge server, the client clicks on the markup request to access the target server).

4. Claims 1-3, 19-21, 24 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles (USP 5933811).

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Regarding claims 1-3, Angles discloses (Fig 2, Col 2, lines 45 to col 23, lines 55) a server for receiving a request from the client system to a target server, providing addition information from server and information from the target server to the client system ( an advertising server "18" which receives a request from user "12" to target server "14", provides an addition content of the advertinsing server such as advertisement and content of the target server to the user).

Regarding claims 19-21 and 24, Angles discloses (Fig 2, Col 2, lines 45 to col 23, lines 55) a server (Fig 2, Ref 18) for providing a control logic for receiving a request for content from the client system (Fig 2, Ref 12) targeting a network server (Fig 2, 14) checking whether an addition content inquiry is to be provided to the client system along with the content which provides by the network server, content adding logic which coupled to the control logic for providing the additional content to the client system if it is to be additionally provides (Angles discloses a user login the ISP "Fig 2, 34" searching for a target server "Fig 2, 14", the advertising server (Fig 2, 18) receives a request for content of target server, check to see if any addition contents need to provide to the client system along with the content of the target server. The adverting server embedded the advertising into the content of target server HTML page then forwarding it to the client system).

Regarding claim 29, Angles discloses (Fig 2, Col 2, lines 45 to col 23, lines 55) a client system which comprises a control logic to transmitting a request that target a network server and retransmit the request in the mark up form upon receiving a return of request from a bridge server (See Fig 2, the client system 12 transmitting a request that target a server 14; after receiving a

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marked up form from the bridge server 18, the client clicks on the markup request to access the target server).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 6-11, 13-18, 22-23, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman as applied to claim 1, 19, 24 and 29 above, and further in view of Gabber (USP 5961593) and Rondeau (USP 5850433).

Regarding claims 4, 6-11 and 13-18, Merriman discloses a method of tracking the target advertisement for delivering to the client system (See Abstract, col 2, lines 7-45 and col 2, lines

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59 to col 4, lines 55, Col 7, lines 15-44). However, Merriman fails to disclose an additional content is a telephone number which allow a user to contact with the customer's representative and method of removing the mark up requests before forwarding the request to target server. However, Rondeau discloses an addition content includes an option for making a telephone call without requiring provision of a telephone number by a user and termination of current client system to network communication; automatically establishing a telephone to PSTN hand set; providing an URLS hyper text link (marked URLS) to the client system so that the client can access the web site of addition content by click on the hot spot such underline hyper link, image etc.... Furthermore, returning a marked version of the request to the client system; when the user clicks on the marked version, the ISP checks which proxy server has stored a current information and removing the marked version which provides at the current proxy server marked the request (Col 1, lines 1 to Col 16, lines 12) returning an HTML page to client system which includes marked version of the request, a marked identifier of the additional content, the request, identifier of additional content, and addition content. For example, when the client searches for a product, the ISP generates an HTML page which contains a marked version of the request such as highlight URLS or words and a marked identifier of additional content such as telephone Icon, Hyper text link host spot etc....; Gabber discloses a method of removing the mark up requests before forwarding the request to target server (Fig 6).

Since the method of creating a hyper link or button with a telephone number is well known in the art as taught by Rondeau. Therefore, it would have been obvious to one of ordinary

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skill in the art at the time of the invention was made to apply Rondeau's teaching and a method of removing a mark up tag before transmitting a request to a target server as taught by Gabber into the method of Merriman. The suggestion/motivation would have been to reduce the cost of consumer access fees.

Regarding claim 22, Merriman fails to disclose a method of allowing the user automatically to establish a voice call to a PSTN handset in response to select an additional content by a user. However, in the same field of endeavor, Rondeau discloses a method of allowing the user automatically to establish a voice call to a PSTN handset in response to select an additional content by a user (See Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of embedded a telephone number into a button to allow the user to contact the customer's representative as taught by Rondeau into the Merriman's method. The motivation would have been to allow the customer interactive to a customer representative right away, if the customer does not satisfy with a detail description on the web page.

Regarding claims 23 and 25, Merriman fails fully disclose a control logic which marks up the request and return the request to client system for resubmitting, after receiving the marked up, remove the mark up request then forwarding the request to target server. However, Gabber discloses a method of removing the marked up before forwarding the request to target server (Fig 6, disclose a marked up tag removed before forwarding to the target server).



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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of removing the marked tag as taught by Gabber et al into Merriman's method. The motivation would have been to provide anonymous retransmission of browsing command by the client system.

Regarding claim 30, Merriman fails fully to disclose a method of allowing the client system to transmitting another request for addition content, upon receipt of an identifier of additional content from the bridge server provided in response to the first transmission request. However, Rondeau discloses a method of allowing the client to transmitting another request after receiving an identifier of the additional content from the bridge server (After receiving a search report the client clicks on the telephone icon to speak with the representative or can click on the Hot link which has an address of the another web sites to access the advertisement is well known in the art by using HTML, See Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of embedded a telephone number into a button to allow the user to contact the customer's representative as taught by Rondeau into the Merriman's method. The motivation would have been to allow the customer interactive to a customer representative right away, if the customer does not satisfy with a detail description on the web page.

7. Claims 4, 6-11, 13-18, 22-23, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles as applied to claim 1, 19, 24 and 29 above, and further in view of Gabber (USP 5961593) and Rondeau (USP 5850433).

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Regarding claims 4, 6-11 and 13-18, Angles discloses in addition to the features set forth in claim 1, Angles (see Abstract, col. 2, line 45 to col. 23, line 55) discloses the features set forth as claimed. However, Angles fails to disclose an additional content is a telephone number which allow a user to contact with the customer's representative and method of removing the mark up requests before forwarding the request to target server. However, Rondeau discloses an addition content includes an option for making a telephone call without requiring provision of a telephone number by a user and termination of current client system to network communication; automatically establishing a telephone to PSTN hand set; providing an URLS hyper text link (marked URLS) to the client system so that the client can access the web site of addition content by click on the hot spot such underline hyper link, image etc.... Furthermore, returning a marked version of the request to the client system; when the user clicks on the marked version, the ISP checks which proxy server has stored a current information and removing the marked version which provides at the current proxy server marked the request (Col 1, lines 1 to Col 16, lines 12) returning an HTML page to client system which includes marked version of the request, a marked identifier of the additional content, the request, identifier of additional content, and addition content. For example, when the client searches for a product, the ISP generates an HTML page which contains a marked version of the request such as highlight URLS or words and a marked identifier of additional content such as telephone Icon, Hyper text link host spot etc....; Gabber discloses a method of removing the mark up requests before forwarding the request to target server (Fig 6).

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Since the method of creating a hyper link or button with a telephone number is well known in the art as taught by Rondeau. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply Rondeau's teaching and a method of removing a mark up tag before transmitting a request to a target server as taught by Gabber into the method of Angles. The suggestion/motivation would have been to reduce the cost of consumer access fees.

Regarding claim 22, Angles fails to disclose a method of allowing the user automatically to establish a voice call to a PSTN handset in response to select an additional content by a user. However, in the same field of endeavor, Rondeau discloses a method of allowing the user automatically to establish a voice call to a PSTN handset in response to select an additional content by a user (See Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of embedded a telephone number into a button to allow the user to contact the customer's representative as taught by Rondeau into the Angles' method. The motivation would have been to allow the customer interactive to a customer representative right away, if the customer does not satisfy with a detail description on the web page.

Regarding claims 23 and 25, Angles fails fully disclose a control logic which marks up the request and return the request to client system for resubmitting, after receiving the marked up, remove the mark up request then forwarding the request to target server. However, Gabber

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discloses a method of removing the marked up before forwarding the request to target server (Fig 6, disclose a marked up tag removed before forwarding to the target server).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of removing the marked tag as taught by Gabber et al into Angles' method. The motivation would have been to provide anonymous retransmission of browsing command by the client system.

Regarding claim 30, Angles fails fully to disclose the claimed invention. However, Rondeau discloses a method of allowing the client to transmitting another request after receiving an identifier of the additional content from the bridge server (After receiving a search report the client clicks on the telephone icon to speak with the representative or can click on the Hot link which has an address of the other web sites to access the advertisement is well known in the art by using HTML, See Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of embedded a telephone number into a button to allow the user to contact the customer's representative as taught by Rondeau into the Angles' method. The motivation would have been to allow the customer interactive to a customer representative right away, if the customer does not satisfy with a detail description on the web page.

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*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Radziewicz (USP 5854897) discloses a communication system which allows a client system to obtain the addition information along with the content information from content provider.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

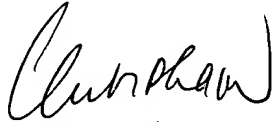
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378.

The fax phone number for this group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen  
Art Unit 2731  
December 13, 1999

  
CHI H. PHAM  
SUPERVISORY PATENT EXAMINER  
GROUP 2700  
12/16/99